

REMARKS

Pending claims

Claims 1-48 were originally filed. Claims 8, 10, 18-26 and 29-44 were canceled under item 3 on page 1 of the Request for Filing a Patent Application Under 37 CFR 1.53(b) mailed on June 11, 2001 and received in the USPTO on June 25, 2001. Claims 1-7, 9, 11-17, 27-28 and 45-48 are pending in this application.

Restriction Requirement

In the Restriction Requirement, the Examiner requested Applicants to elect one of the following inventions:

Group I (claims 1-2, 16-17, 45-46) drawn to a polypeptide, SEQ ID NO:1. *Note that claim 46 is drawn to SEQ ID NO:3 and, therefore, does not belong in the Group I claims.*

Group II (claims 3-7, 9, 11, 47-48) drawn to a polynucleotide encoding SEQ ID NO:1. *Note that claim 48 is drawn to a polynucleotide sequence of SEQ ID NO:4 which encodes SEQ ID NO:3 and, therefore, does not belong in the Group II claims.*

Group III (claim 12) drawn to a polynucleotide probe, derived from SEQ ID NO:2.

Group IV (claims 13-15) drawn to a method of detecting with a polynucleotide of SEQ ID NO:2. *Note that these claims have been mischaracterized as being drawn to a method of detecting **with** a polynucleotide of SEQ ID NO:2 while the claim language actually recites that the **target polynucleotide** is a polynucleotide of claim 11 (e.g., SEQ ID NO:2).*

Group V (claim 27) drawn to a method of screening with a polynucleotide of SEQ ID NO:2. *Note that this claim has been mischaracterized as being drawn to a method of screening **with** a polynucleotide of SEQ ID NO:2 while the claim language actually recites that the **target polynucleotide** comprises a polynucleotide of claim 5 (e.g., SEQ ID NO:2).*

Group VI (claim 28) drawn to a method of screening with a probe derived from SEQ ID NO:2.

Group VII (claims 1-2, 16-17, 45-46) drawn to a polypeptide, SEQ ID NO:3. *Note that claim 45 is drawn to SEQ ID NO:1 and, therefore, does not belong in the Group VII claims.*

Group VIII (claims 3-7, 9, 11, 47-48) drawn to a polynucleotide encoding SEQ ID NO:3. *Note that claim 47 is drawn to a polynucleotide sequence of SEQ ID NO:2 which encodes SEQ ID NO:1 and, therefore, does not belong in the Group VIII claims.*

Group IX (claim 12) drawn to a polynucleotide probe, derived from SEQ ID NO:4.

Group X (claims 13-15) drawn to a method of detecting with a polynucleotide of SEQ ID NO:4. *Note that these claims have been mischaracterized as being drawn to a method of detecting **with** a polynucleotide of SEQ ID NO:4 while the claim language actually recites that the **target polynucleotide** is a polynucleotide of claim 11 (e.g., SEQ ID NO:4).*

Group XI (claim 27) drawn to a method of screening with a polynucleotide of SEQ ID NO:4. *Note that this claim has been mischaracterized as being drawn to a method of screening **with** a polynucleotide of SEQ ID NO:4 while the claim language actually recites that the **target polynucleotide** comprises a polynucleotide of claim 5 (e.g., SEQ ID NO:4).*

Group XII (claim 28) drawn to a method of screening with a probe derived from SEQ ID NO:4.

Applicants hereby elect, with traverse, to prosecute Group VIII which includes and is drawn to claims 3-7, 9, 11 and 48. Applicants reserve the right to prosecute non-elected subject matter in subsequent divisional applications.

Applicants traverse this Restriction Requirement on several grounds.

First, Applicants traverse the Restriction Requirement as between the claims of Group VIII (claims 3-7, 9, 11 and 48) and Group IX (claim 12) drawn to a polynucleotide probe derived from SEQ ID NO:4. The search of the claimed polynucleotides would totally include all such probes and shorter sequences that are derived from SEQ ID NO:4. Since this is essentially an identical search to the one which would be performed for the claimed polynucleotides, it would not be an undue burden on the Examiner.

Second, Applicants traverse the Restriction Requirement as between the claims of Group VIII (claims 3-7, 9, 11 and 48) and Group VII (claims 1-2, 16-17 and 46) drawn to polypeptides related to SEQ ID NO:4. Many of the elected claims of Group VIII are directed specifically to polynucleotides encoding the claimed polypeptides of Group VII, and thus it is presumed that a proper search for the claimed polynucleotides would include the polypeptides which they encode. Therefore, it is submitted that it would not be a substantial burden on the Examiner to use the results of the necessary polynucleotide search to examine the polypeptide claims.

Therefore, it is respectfully submitted that, upon searching and examining polynucleotides encoding the polypeptides relating to SEQ ID NO:3 and finding no prior art over which they can be rejected, the search should be extended to include the polypeptides encoded by SEQ ID NO:4 and the shorter sequences encompassed by the polynucleotide probes.

Rejoinder

Applicants traverse the Restriction Requirement on the grounds that the Examiner could also examine the claims of Group X (claims 13-15) drawn to methods of detecting a target polynucleotide having a sequence of a polynucleotide of claim 11, and Groups XI (claim 27) and XII (claim 28) drawn to methods of screening for a target polynucleotide having a sequence of a polynucleotide of claim 5. The Examiner's attention is directed to the Commissioner's Notice in the Official Gazette of March 26, 1996, entitled "Guidance on Treatment of Product and Process Claims in Light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)" which sets forth the rules, upon allowance of product claims, for rejoinder of process claims covering the same scope of products. Therefore, upon allowance of any of the claims within Group VIII, *i.e.* claims 3-7, 9, 11 and 48, the method claims 13-15 and 27-28, which depend therefrom, should be rejoined and examined.

CONCLUSION

In light of the above amendments and remarks, Applicants submit that the present application is fully in condition for allowance. Early notice to that effect is earnestly solicited.

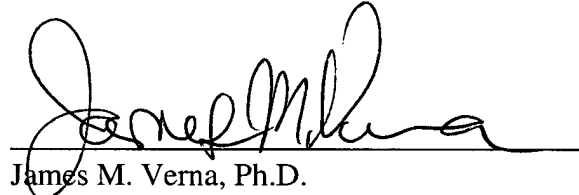
If the Examiner contemplates other action, or if a telephone conference would expedite allowance of the claims, Applicants invite the Examiner to contact the undersigned at the number listed below.

Applicants believe that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. **09-0108**.

Respectfully submitted,

INCYTE CORPORATION

Date: 30 June 2003

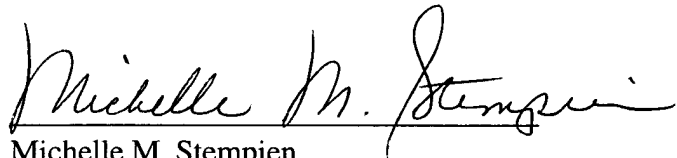


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